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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/664,685	09/17/2003	Kevin R. Willett	85939.000678	4079
23387	7590	05/26/2004	EXAMINER	
Stephen B. Salai, Esq. Harter, Secrest & Emery LLP 1600 Bausch & Lomb Place Rochester, NY 14604-2711				ENGLE, PATRICIA LYNN
ART UNIT		PAPER NUMBER		
		3612		

DATE MAILED: 05/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/664,685	WILLETT, KEVIN R.
Examiner	Art Unit	
Patricia L Engle	3612	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_\_.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-44 is/are pending in the application.  
 4a) Of the above claim(s) 32-44 is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-31 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 17 September 2003 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachments(s)

- 1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date 12/23/03.

- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_.  
 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-31, drawn to a flange cover, classified in class 296, subclass 93.
  - II. Claims 32-44, drawn to a method of installing a flange cover, classified in class 29, subclass 897.2.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product can be used in a materially different process. The weather strip is not required to be engaged with the flange robotically.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Brian Shaw on May 17, 2004 a provisional election was made with traverse to prosecute the invention of the flange cover, claims 1-31. Affirmation of this election must be made by applicant in replying to this Office action. Claims 32-44 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-6, 8-15 and 17-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Ogawa et al. (US Patent 5,449,544).

Regarding claims 1, 10, 19 and 28, Ogawa et al. disclose a flange cover with trim lip for engaging a flange (1) having a terminal edge (1) and a pair of opposed sides, the flange cover (W1) comprising a generally concave body consisting essentially of a closed end (3), a flange engaging leg (2) and a trim lip (5,7), the flange engaging leg (2) extending from the closed end (3) for being affixed (at 43) to the first side of the flange (1), and the trim lip (5,7) extending from the closed end (3) to be spaced from the second side of the flange (1) along an entire length of the trim lip (5,7).

Regarding claims 2, 11 and 20, Ogawa et al. disclose the flange cover with trim lip of Claim 1, wherein the body is formed of a polymeric material (EPDM rubber).

Regarding claims 3, 12, and 21, Ogawa et al. disclose the flange cover with trim lip of Claim 1, wherein the body is free of a carrier (Fig. 1).

Regarding claims 4, 13 and 22, Ogawa et al. disclose the flange cover with trim lip of Claim 1, wherein the body is free of structural metal (Fig. 1).

Regarding claims 5, 14 and 23, Ogawa et al. disclose the flange cover with trim lip of Claim 1, further comprising an adhesive (43) for bonding an inside surface of the flange engaging leg (2) to the first side of the flange (1).

Regarding claims 6, 15 and 24, Ogawa et al. disclose the flange cover with trim lip of Claim 1, further comprising a sealing member (19) extending from an outside surface of the flange engaging leg (2).

Regarding claims 8, 17 and 26, Ogawa et al. disclose the flange cover with trim lip of Claim 1, wherein the trim lip (5,7) has a varying cross section (5 and 7) along a length of the trim lip.

Regarding claims 9, 18 and 27, Ogawa et al. disclose the flange cover with trim lip of Claim 1, wherein the trim lip (5) defines a hollow section (9) within a cross section of the trim lip.

7. Claims 28-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Dupuy (US Patent 5,511,344).

Regarding claim 28, Dupuy disclose a flange cover for operable location relative to a vehicle flange (32) and a spaced interior trim piece (22), the vehicle flange (32) having a first side and a second side, the flange cover comprising: (a) a flange cover body (22) configured to engage only a single side (along 26) of the flange (32) and preclude contact with the second side of the flange; and (b) a trim lip (24) extending from the flange body (26) to locate a portion of the interior trim piece intermediate the trim lip (24) and the second side of the flange (32).

Regarding claim 29, Dupuy disclose the flange cover of Claim 28, wherein the trim lip (24) is sized to occlude the gap.

Regarding claim 30, Dupuy disclose the flange cover of Claim 28, further comprising one of a reinforcing member and an elongation reducing member (28) in the flange cover body.

Regarding claim 31, Dupuy disclose the flange cover of Claim 28, wherein the flange cover body is free of structural metal (Fig. 2).

### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 7 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ogawa et al.

Ogawa et al. disclose the flange cover with trim lip of claims 1 and 10. Ogawa et al. do not disclose that the flange engaging leg includes a sealing bulb. The flange engaging leg of Fig. 3 of Ogawa et al. disclose a sealing bulb attached to the flange engaging leg. It would have been obvious to one of ordinary skill in the art at the time of the invention to place a sealing bulb on the flange engaging leg of Fig. 1. The motivation would have been to seal the flange with another member on the flange engaging leg side of the flange.

### ***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art discloses other flange engaging members.

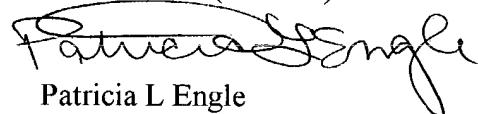
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11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L Engle whose telephone number is (703) 306-5777.

The examiner can normally be reached on Monday - Friday from 8:00 to 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, D. Glenn Dayoan can be reached on (703) 308-3102. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Patricia L Engle  
Examiner  
Art Unit 3612

ple  
May 17, 2004